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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,905	01/28/2002	Masahiro Yanagisawa	218202US0	1491

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ROBERTSON, JEFFREY

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/055,905

Examiner

Jeffrey B. Robertson

Applicant(s)

YANAGISAWA, MASAHIRO

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-- The MAILING DATE of this communication appears on the cover sheet with the c rresp ndence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-23 is/are rejected.
- 7) ☒ Claim(s) 6-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 5-23, and Species A, claims 5-12, 15-17, and 22 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the office has merely stated a conclusion that the intermediate product is useful for a golf ball material and that the office has not shown that the inventions of Groups I and II are materially different. The examiner has found the grounds of traversal regarding Groups I and II and the Species election persuasive, and therefore all the claims have been examined. The requirement for restriction and election of species is withdrawn.

Drawings

2. Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Alli et al. (U.S. Patent Application Publication US 2001/0049400 A1).

For claim 1, on page 2, paragraph [0017], Alli teaches a macromer containing a monomer that is a monomethacryloxypropyl terminated monobutyl-terminated polydimethylsiloxane. This falls within applicant's formula (1) when R1=methyl, x=3, and R2=butyl. Here, Alli teaches that 2-hydroxyethyl methacrylate is also used. This corresponds to applicant's requirement that a monomer with a basic group (OH) be present. For claim 2, Alli teaches that a monomer dimethylacrylamide is added, a monomer having nonionic polar groups other than oxyalkylene and polyoxyalkylene groups. Alli does not specifically teach that the polymer is soluble in silicone oil. However, this would appear to be an inherent property of the polymer produced. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

5. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Maiden et al. (U.S. Patent No. 6,367,929).

For claims 1 and 2, in column 6, lines 52-57, Maiden teaches a polymer that is made from monomethacryloxypropyl terminated monobutyl-terminated polydimethylsiloxane. This falls within applicant's formula (1) when R1=methyl, x=3, and R2=butyl. Here, Maiden teaches that 2-hydroxyethyl methacrylate is also used. This corresponds to

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applicant's requirement that a monomer with a basic group (OH) be present. For claim 2, in column 7, lines 37-49, Maiden teaches that a monomer dimethylacrylamide is added, a monomer having nonionic polar groups other than oxyalkylene and polyoxyalkylene groups. Note that in column 5, lines 21-22, the full definition of DMA is given. Maiden does not specifically teach that the polymer is soluble in silicone oil. However, this would appear to be an inherent property of the polymer produced.

"Products of identical chemical composition can not have mutually exclusive properties."

A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

6. Claims 5, 10, 11, 13, 14, 16-20, 22, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Albert (U.S. Patent No. 6,300,932).

For claims 5 and 13, in Figure 9, and column 9, lines 19-31, Albert teaches a display cell containing two electrodes (reference #53) opposed to each other. In Figure 9, light is indicated as moving through the upper or display electrode. In column 11, lines 57-58, Albert teaches that the electrodes may be clear. In column 12, line 35 through column 13, line 61, Albert teaches colored particles. In column 16, lines 32-37, Albert discloses the use of silicone oils as suspending fluid. In column 18, lines 57-65, Albert discloses the use of polymers that have oil-soluble portions, allowing for solubility in the silicone oil. For claim 10, in column 21, line 65 through column 22, line 10, Albert teaches water-soluble polymers as binder materials, which would not be soluble in the

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silicone oil. For claims 11 and 20, in column 9, lines 61-67, Albert discloses particle diameters from 10 nm to 5 micrometers, which overlaps the range claimed by applicant. For claims 13, 16 and 17, in column 17, lines 54-65, Albert teaches that the particles may contain acidic or basic surfaces. In column 17, lines 44-65 and column 18, lines 32-65, Albert teaches that an acid-base reaction occurs, which means that if the particle has acidic groups, polymer contains basic groups and if the particle has basic groups the polymer would have acidic groups. For claim 18, in column 22, line 17, Albert teaches acrylic binders, which contain acidic groups. For claims 14 and 19, Albert teaches in column 20, lines 20-31, Albert teaches that the particles can be grafted with acid groups and amiphipathic polymers. For claims 22 and 23, Albert teaches in column 7, lines 7-26, the presence of voltage connectors to apply a voltage in order to display an image. See also Figure 2.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maiden et al. (U.S. Patent No. 6,367,929) as applied to claims 1 and 2 above.

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For claims 3 and 4, Maiden teaches the limitation of claims 1 and 2 as detailed above. In column 5, lines 19-26, Maiden teaches the use of polyethyleneglycol monomethacrylate. This recitation falls with applicant's definition of claim 3, where R_3 =methyl, $x=2$, and R_4 =H. Maiden does not expressly teach that the integer range of y is between 1 and 25. However, this range is a result effective variable that would depend on the desired hydrophilicity of the resulting polymer product. A result effective variable is determined according to the desired properties of the resulting composition and would be obvious to one of ordinary skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

9. Claims 12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albert (U.S. Patent No. 6,300,932) as applied to claims 5 and 13 above.

For claims 12 and 21, Albert teaches the limitations of claims 5 and 13 as detailed above. In column 23, lines 6-11, Albert teaches the addition of water at low concentrations. Albert does not specifically teach the range claimed by applicant. However this range would be a result effective variable depending on the nature of the dispersions desired, and the solubility of the components used in the medium. A result effective variable is determined according to the desired properties of the resulting composition and would be obvious to one of ordinary skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Allowable Subject Matter

10. Claims 6-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the

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base claim and any intervening claims. Although the Alli teaches the composition claimed in claims 1 and 2, and Maiden teaches the composition claimed in claims 1-4, there is no suggestion to use the composition in the materials of Albert. One of ordinary skill in the art would have no motivation to use the contact lens compositions of Alli and Maiden in the displays of Albert.

Conclusion

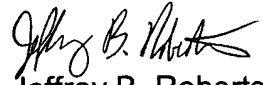
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vanderlaan et al. (U.S. Patent No. 5,998,498), Ogawa (U.S. Patent No. 6,542,284), Shigehiro et al. (US 2002/0044333 A1), and Webber (US 2002/0180687 A1) are cited for general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR